

In re Patent Application of:

CHAPMAN ET AL.

Serial No. 09/596,629

Confirmation No. 4379

Filing Date: June 19, 2000

REMARKS

Applicants would like to thank the Examiner for the courtesies extended during the telephone conference on January 5, 2009. During the telephone conference, the Examiner indicated that the proposed claim amendments provided to the Examiner on December 22, 2008 define over the current prior art rejection.

The claims have now been amended as proposed to the Examiner. Support for the claim amendments are best illustrated in FIG. 4. The claim amendments better illustrate the "options" that are available when creating an invention disclosure. The claim amendments and arguments supporting patentability of the claims are provided below.

I. The Amended Claims

The present invention, as recited in amended independent Claim 1, for example, is directed to a method for distributing an invention disclosure over an intranet. The method comprises accessing an invention disclosure template form over the intranet, with the invention disclosure template form providing the following options: create an invention disclosure, add attachments to an invention disclosure, revise an invention disclosure, send an invention disclosure to a co-inventor, view an unsubmitted invention disclosure, and submit an invention disclosure. The invention disclosure is created by selecting the corresponding option in the accessed invention disclosure template form, with the invention disclosure providing information about an invention.

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An attachment is added to the invention disclosure by selecting the corresponding option in the accessed invention disclosure template form, with the attachment providing additional information about the invention and with the attachment being added without the use of a hyperlink. The invention disclosure is submitted by selecting the corresponding option in the accessed invention disclosure template form, with the invention disclosure being submitted along with the attachment over the intranet to at least one evaluator via e-mail with a hyperlink to the invention disclosure. Evaluation comments on the invention disclosure and the attachment are transmitted by the at least one evaluator via e-mail.

The present invention advantageously allows separately created files to be attached to the invention disclosure. As what typically happens with inventors, an inventor creates a file on their invention prior to creating and submitting an invention disclosure. The invention disclosure template form includes a provision to include these files as attachments. Without this provision, the additional information in the files would have to be retyped, or as a minimum, cut and pasted into the invention disclosure - both of which are labor intensive and time consuming.

Independent Claim 12 is similar to independent Claim 1 but further recites creating a profile of the invention disclosure, identifying first and second groups of users based upon the created profile, and transmitting first and second notification messages based to the respective first and second

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groups of users. Independent Claim 22 is similar to independent Claim 12, but further recites who the members are making up the first and second groups of users.

Independent Claim 31 is directed to an intranet for distributing an invention disclosure as recited in Claim 1. Independent Claim 42 is also directed to an intranet for distributing an invention disclosure as recited in Claim 12. Similarly, independent Claim 52 is also directed to an intranet for distributing an invention disclosure as recited in Claim 22. Independent Claim 61 is directed to a computer readable medium as recited in Claim 1.

II. The Claims Are Patentable

The Examiner rejected independent Claims 1, 12, 22, 32, 42, 52 and 61 over the Hager et al patent in view of the Kuzma patent.

In the Hager et al. patent, an automation of procedures in a local area network (LAN) environment is disclosed. The procedures are automated in a data processing system with regard to the invention disclosures stored therein. As correctly noted by the Examiner, Hager et al. fails to disclose 1) an attachment for the invention disclosure that is created separate from the invention disclosure and is then attached thereto, and 2) submitting the invention disclosure to at least one evaluator with a hyperlink to the invention disclosure.

The Examiner takes Official Notice that it is well known in the art at the time of the invention to send a hyperlink

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to a document instead of an entire document. The Examiner thus takes the position that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Hager et al. with the idea of sending a hyperlink instead of an entire document.

In addition, the Examiner cited the Kuzma patent as disclosing an attachment being included with a document. However, the Examiner correctly notes that the selective combination of Hager et al. and Kuzma fails to teach or suggest attaching a file to the invention disclosure without the use of a hyperlink, with the file having been created by the inventor separate from the invention disclosure, and including information about the invention that is not included in the invention disclosure. Nonetheless, the Examiner takes the position that it would have been obvious to one of ordinary skill in the art at the time of the invention to attach a Word or PowerPoint document as argued by the Appellants rather than attach a hyperlink to such a document.

The Appellants respectfully submit that even if the references were selectively combined as suggested by the Examiner, the claimed invention is still not produced. Even though Hager et al. discloses the creation and distribution of an invention disclosure document, Hager et al. fails to disclose an invention disclosure template form providing the following user selected options: 1) create an invention disclosure, 2) add attachments to an invention disclosure, 3) revise an invention disclosure, 4) send an invention disclosure to a co-inventor, 5)

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view an unsubmitted invention disclosure, and 6) submit an invention disclosure.

Instead, Hager et al. discloses the creation of an invention disclosure document that is then automatically distributed for revision, co-inventor review and transmission to an evaluator. Even though similar functions are being performed, Hager et al. fails to disclose that the invention disclosure document is created from an invention disclosure template form providing user selected options which then allow the different functions to be performed.

Hager et al. will now be discussed in terms of not providing an attachment option to the invention disclosure document. Referring initially to FIG. 2 of Hager et al., a high level flow chart illustrating the creation of an invention disclosure document is provided. Reference is directed to column 4, lines 44-53 of Hager et al., which provides:

"As is illustrated, the process begins at block **48** and thereafter passes to block **50** which depicts the creation of an invention disclosure document. In the preferred embodiment, the user is prompted for personal information about each inventor, critical dates information about statutory bar dates, and information about the problem solved and the solution. Next, block **52** gives the user the opportunity to revise the invention disclosure document, if such revision is necessary." (Emphasis added).

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As highlighted above, in the preferred embodiment of Hager et al., the user is prompted for information about the problem solved and the solution. This means that the information to be evaluated as part of the invention disclosure must be typed in by the user.

If the amount of information to be entered is rather large, then this becomes a labor intensive and time consuming task for the inventor as well as not being user friendly to the inventor. If the inventor becomes impatient and fails to provide a sufficient amount of information about his invention, then one or more of the evaluators may not properly understand or appreciate the invention - thus resulting in an unfavorable evaluation.

Hager et al. thus fails to teach or suggest providing options to the inventor when creating an invention disclosure, wherein a file describing the invention can be attached to the invention disclosure without the use of a hyperlink, as recited in the claimed invention.

An object of the Hager et al. patent is to automatically generate reports and to initiate additional procedures with regards to the invention disclosure document within a data processing system. In other words, Hager et al. provides sufficient detail on soliciting an evaluation vote from users automatically determined in response to identification of a functional area associated with the invention disclosure, as illustrated in FIGS. 3-5. However, Hager et al. simply fails to

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provide user selected options via an invention disclosure template form when creating an invention disclosure.

Referring now to the Kuzma patent, e-mail attachments are transmitted from a sender of a network to a recipient of the network. The attachments are stored in a storage device visible to the network and relatively local to the sender. Each attachment has a unique network address associated therewith. The sender requests an e-mail option from the recipient, which provides a configurable e-mail page to the sender in response to the request. An attachment reference comprising the network address of the attachment is supplied to the configurable e-mail page. Reference is directed to column 4, line 65 to column 5, line 6 of Kuzma, which provides:

"Referring now to FIG. 4, there is illustrated an e-mail message format **400** in accordance with a preferred embodiment of the present invention. In the e-mail message format **400** of the present invention, when a user such as **PC 210** of FIG. 2 wishes to send an attachment with an e-mail message to a user such as **PC 212**, the e-mail message **401** is transmitted along with a relatively small attachment reference **402**, instead of actually transmitting the entire attachment file along with e-mail message **401** ..."
(Emphasis added.)

As correctly noted by the Examiner, the attachment as disclosed in Kuzma is created separate from the document (i.e., an e-mail), and the attachment is included with the document.

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The Examiner has taken the position that it would have been obvious to combine the teachings of Hager et al. with the teachings of Kuzma regarding creating an attachment separately from a document.

The Appellants respectfully submit that even if the references were combined as suggested by the Examiner, the claimed invention is still not produced. Kuzma discloses the use of an attachment reference being supplied with the document instead of supplying the contents of the attachment. The attachment reference is essentially a hyperlink to the attachment.

In sharp contrast, the present invention recites that the file is attached to the invention disclosure without the use of a hyperlink. When a file in the present invention is attached to the invention disclosure, it is "fixed" thereto, i.e., the contents of the file are sent along with the invention disclosure itself. As a result of the inventor being able to easily add information about the invention to the invention disclosure, the evaluators are more likely to provide an accurate evaluation of the invention.

Accordingly, it is submitted that amended independent Claim 1 is patentable over Hager et al. in view of Kuzma. Independent Claims 12, 22, 31, 42, 52 and 61 have been amended similar to amended independent Claim 1. Therefore, it is submitted that these claims are also patentable over Hager et al. in view of Kuzma.

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In view of the patentability of amended independent Claims 1, 12, 22, 31, 42, 52 and 61, it is submitted that their dependent claims, which recite yet further distinguishing features of the invention, are also patentable. These dependent claims require no further discussion herein.

III. CONCLUSION

In view of the claim amendments and arguments provided herein, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,



MICHAEL W. TAYLOR
Reg. No. 43,182
Allen, Dyer, Doppelt, Milbrath
& Gilchrist, P.A.
255 S. Orange Avenue, Suite 1401
Post Office Box 3791
Orlando, Florida 32802
407-841-2330